

**Appl. No. 10/657,585**

**Response dated February 7, 2006**

**Reply to Notice of Non-Compliant Amendment dated January 17, 2006**

### **REMARKS**

Applicant acknowledges receipt of the Notice of Non-Compliant Amendment dated January 17, 2006 for the claim amendment filed in the Response dated December 16, 2005 in reply to the Final Office Action dated October 17, 2005.

In the Final Office Action dated October 17, 2005, Claims 1-3, 6-11, 13-28, 30, 32-36, 40-45, 47-49, 51-55, 57-60 and 62 were rejected under 35 U.S.C. § 103 as being unpatentable over *Hindin et al.*, U.S. Patent No. 3,993,572 ("*Hindin*"). Furthermore, Claims 4-5, 29, 37-38, 56 and 61 were rejected under 35 U.S.C. § 103 as being unpatentable over *Hindin* in view of U.S. Patent No. 6,596,667 ("*Bellussi*"). In addition, Claims 12, 31, 39, 46, and 50 were objected as being dependent upon a rejected base claim but allowable if rewritten in independent form to include the limitations of the base and any intervening claims. Claims 63-75 are withdrawn as non-elected claims in the Application.

#### **I. Status of the Claims**

By this Response, Claims 1, 21, 32, 37-38, 49, 63, 66 & 75 are currently amended; Claims 12, 31, 33, 36, 39-41, 50 & 72-73 are canceled; and Claims 76-78 are new.

Claims 63-71, 74 & 75 are withdrawn.

Claims 1-11, 13-30, 32, 34, 35, 37, 38, 42-49, 51-71 & 74-78 are currently pending, in which

- Claim 1 is an elected independent claim from which Claims 2-11 and 13-20 depend;
- Claim 21 is an elected independent claim from which Claims 22-30 depend;
- Claim 32 is an elected independent claim from which Claims 34, 35, 37, 38, 42-48 & 76 depend;
- Claim 49 is an elected independent claim from which Claims 51-62, 77 & 78 depend; and
- Claim 63 is a nonelected independent claim from which Claims 64-71, 74 & 75 depend.

#### **II. Amendments to Claims 1, 21, 32 and 49 with allowable subject matter render elected claims 1-11, 13-30, 32, 34, 35, 37, 38, 42-49 & 51-62 allowable.**

As stated in the Remarks section of the Response filed on December 16, 2005, Applicant amended independent Claims 1, 21, 32 and 49 to contain all the limitations of objected Claims 12, 31, 39 and 50, respectively. In addition, Applicant canceled Claim 12, 31, 36, 39 (which depends on

**Appl. No. 10/657,585**

**Response dated February 7, 2006**

**Reply to Notice of Non-Compliant Amendment dated January 17, 2006**

intervening Claim 36) and 50 to avoid duplication. Applicant further canceled Claims 33, 40 and 41 (which depends from Claim 40), as these claims cover a broader scope or other embodiments of the invention which are not covered by the scope of the currently-amended independent Claim 32 from which they ultimately depend. Applicant further amended Claims 37 and 38 to change the dependency from a now-canceled Claim 36 to currently-amended Claim 32.

Applicant believes that currently-amended independent Claims 1, 12, 32 and 49 are now in allowable form. Applicant further submits that Claims 2-11 and 13-20 which depend from currently-amended independent Claim 1; Claims 22-28 and 30 which depend from currently-amended independent Claim 21; Claims 34, 35, 37, 38 and 42-48 which depend from currently-amended independent Claim 32; and Claims 51-62 which depend from currently-amended independent Claim 49 must also be allowable, as each dependent claim carries with them all the limitations of their respective independent claim.

Thus, Applicant respectfully requests the Examiner to remove the rejections to Claims 1-11, 13-30, 32, 34, 35, 37, 38, 42-45, 47-49 & 51-62 and remove the objection to Claim 46 and to allow all of these pending elected claims.

### **III. New Claims 76-78 are allowable.**

Applicant added new Claim 76 which depends from elected Claim 32 to add an embodiment to which the Applicant is entitled. Claim 76 recites "wherein the catalyst comprises between about 5 and about 40% cobalt" which is supported by the specification and claims as originally filed, for example by at least original Claim 56 and paragraph [0058] of the specification as originally filed. Since new Claim 76 depends from currently-amended Claim 32 which is allowable, Applicant submits that new Claim 76 must also be allowable as it carries all the limitations of such independent claim.

Applicant further added new Claims 77 and 78 which depend from elected Claim 49 via intervening Claim 55 in order to add embodiments to which the Applicant is entitled. Claim 77 recites "wherein the cobalt metal is dispersed in crystallites having an average size of between about 1 nm and about 20 nm", which is supported by the specification and claims as originally filed, for example by at least paragraph [0057] of the specification as filed. Claim 78 recites "wherein the cobalt metal is dispersed in crystallites having an average size of between about 5 nm and about 20 nm", which is supported by the specification and claims as originally filed, for example by at least

**Appl. No. 10/657,585**

**Response dated February 7, 2006**

**Reply to Notice of Non-Compliant Amendment dated January 17, 2006**

original Claim 39 and paragraph [0057] of the specification as filed. Since new Claims 77 and 78 ultimately depend from currently-amended Claim 49 which is allowable, Applicant submits that Claims 77 and 78 must also be allowable, as each carries at least all the limitations of such independent claim.

Applicants submit that the cancellation of a total number of ten (10) claims by this amendment is sufficient to cover these additional three (3) new claims.

Applicant respectfully requests the entry of these new dependent Claims 76-78 and their allowance.

**IV. Amendment of withdrawn process Claims 63-71, 74 and 75 with allowable catalyst composition for the purpose of rejoinder under MPEP § 821.04.**

Claims 63-75 were withdrawn as non-elected claims.

In this reply, independent claim 63 was amended to recite a range of cobalt crystallite average size in order to narrow the catalyst composition, such that withdrawn Claim 63 in its currently-amended form carries all of the limitations pertaining to the catalyst composition of currently-amended (elected) Claim 32 which is allowable.

Applicant further amended withdrawn Claim 66 by removing the word "mostly" to clarify the claim language and to prevent any possible issue under 35 U.S.C. § 112.

Additionally, Applicant amended Claim 75 by replacing "method of" to "process according to" in the preamble of this claim to prevent any possible issue under 35 U.S.C. § 112, and this amendment does not modify the scope of the claim.

Applicants further canceled withdrawn process Claims 72 and 73 (dependent from Claim 72), as they cover the use of other catalyst embodiments which are not included in the scope of currently-amended Claim 63 from which these claims depend.

**Status identifiers**

Claims 72 and 73 are now identified as "Canceled". Withdrawn Claims 63-71, 74 and 75 which are still pending in the application are now identified as "Withdrawn". Based on 37 CFR 1.121(c), the status identifier of "Withdrawn" is proper for any withdrawn claim which is currently amended.

**Appl. No. 10/657,585**

**Response dated February 7, 2006**

**Reply to Notice of Non-Compliant Amendment dated January 17, 2006**

**Rejoinder**

In the Remarks/Arguments section of the Response dated December 16, 2005, Applicant was seeking the rejoinder of withdrawn non-elected Claim 63 and its dependent Claims 64-71, 74 and 75 based on MPEP §821.04, since withdrawn Claim 63, as currently-amended, recites all of the same catalyst limitations as allowable catalyst Claim 32 in its currently amended form. However, in the Notice of Non-Compliant Amendment dated January 17, 2006, the Examiner stated under Item 4.E. that "since the election was made without traverse and that the nonelected claims are drawn to different inventions, they will not be rejoined".

When Applicant searched the MPEP, Patent Laws (USC Title 35), and Patent Rules (CFR Title 37), Applicants found that a traversal of a Restriction Requirement by the Applicant is required to retain the right to petition from the requirement under 37 CFR 1.144, but Applicants could not find a requirement for the Applicant to traverse a Restriction Requirement in order for the nonelected claims to be eligible for a rejoinder based on MPEP § 821.04. Instead, Applicant found that MPEP § 821.02 (see reproduced paragraph below) contradicts the Examiner's statement.

**MPEP § 821.02 After Election Without Traverse:** "... when the application is otherwise ready for \*>allowance<, the claims to the nonelected invention, \*>except for claims directed to< nonelected species >and nonelected inventions eligible for rejoinder<, may be canceled by an examiner's amendment, and the application passed to issue. \*\*> See MPEP § 821.01 and § 821.04 *et seq.*" (emphasis added)

Thus, Applicant deduces that there is no such requirement for the Applicant to traverse the Restriction Requirement for a rejoinder of nonelected claims to take place under MPEP § 821.04, since a rejoinder is possible after an election without traverse under MPEP § 821.02. If Applicant errs in reaching such conclusion, Applicant respectfully asks the Examiner for the citation of the governing rule which serves as the basis of her statement. Otherwise

Accordingly, in view of such conclusion, Applicant respectfully requests the Examiner to reconsider her position regarding the rejoinder of the pending withdrawn process claims.

Applicant contends that this amendment does not raise new issues that would require further consideration (such as issues under 35 U.S.C. §101 or §112, first paragraph) necessitated by the rejoinder of these withdrawn process Claims 63-71, 74 and 75 and respectfully solicits their allowance.

**V. Conclusion**

Entry of the amendments is respectfully requested. Applicant believes the current amendment is

**Appl. No. 10/657,585**

**Response dated February 7, 2006**

**Reply to Notice of Non-Compliant Amendment dated January 17, 2006**

now in compliance with proper Patent and Trademark Office practice. Applicant further submits that *no new matter was introduced* by way of amendment to the claims; and that *the amendment does not raise new issues* that would require further consideration and/or search.

Applicant believes that all pending elected claims in their current form are allowable over the art of record, and respectfully solicits their allowance.

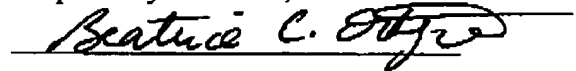
Applicant respectfully requests the rejoinder of pending withdrawn claims based on MPEP §821.04. Applicant believes that withdrawn Claims 63-71, 74 and 75 in their present form are free from 35 U.S.C. §101 or §112, first paragraph issues and are allowable over the art of record. Applicant respectfully solicits their allowance.

The Notice of Non-Compliant Amendment was mailed on January 17, 2006, the end date of the shortened statutory time period set in the Final Office Action dated October 17, 2005. Applicant thus petitions for the Extension of Time necessary in order for this paper to be deemed timely filed. For the timely submission of this paper, Applicant authorizes the Commissioner to charge the required extension of time fee under § 1.17 to Deposit Account Number 16-1575 of ConocoPhillips Company, Houston, Texas.

Should there be any remaining issue which the Examiner believes would possibly be resolved by a conversation, the Examiner is invited to call the undersigned at (281) 293-4751 so that further delay in a Notice of Allowance can be avoided.

Also, if the Examiner is not persuaded that the Application is in condition for allowance and further is not believing that whatever issues remaining can be resolved by a telephone interview before issuing an Advisory Action, the Examiner is requested to at least approve entry of the amendments as they will clearly put this Application in better form for appeal by reducing issues for appeal.

Respectfully submitted,



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